

## R E M A R K S

The last Official Action (Paper No. 11 dated December 8, 1995) has been carefully considered. The Primary Examiner's decision to send a further Action (upon receipt of the Supplemental Amendment dated July 18, 1995) is gratefully acknowledged.

In response to the objection in the last paragraph on page 2 of Paper No. 11, applicants respectfully draw attention to line 5 on page 2, to line 4 on page 7, and to line 7 on page 13 of the original specification. If the Primary Examiner still believes that the matter of the claim 3 is not adequately supported by the disclosure in the application as filed, applicants propose that the claim 3 be cancelled without prejudice.

The amendments to the claims 36, 40 and 70 are believed to overcome the formal objections in the first three paragraphs on page 3 of Paper No. 11.

The twice amended claim 36 recites that the at least one impeller (such as 110) is disposed in and is driven by the at least one housing (such as 102) when the at least one housing is connected with the rotary driving device (such as OD). The recitation of an actual connection between the at least one runner (such as 113) and the rotary driven device (such as ID) is not believed

to be necessary in view of the formulation of the lines 9 through 20 of the twice amended claim 36.

It is to be borne in mind that the power transmitting apparatus which is recited in the claim 36 can be said to constitute a module or a kit, i.e., an assembly of parts which can be stored and/or shipped as such, and applicants consider such assembly, kit or module to be novel and patentable irrespective of whether (i.e., also before) it is actually connected to a rotary driving device and to a rotary driven device. Attention is respectfully invited to the decision by the CCPA in In re Venezia (189 USPQ 149) wherein it was held as follows:

"Claims that define claimed invention's metes and bounds with reasonable degree of precision and particularity are 35 U.S.C. 112, second paragraph, definite; claim language calling for sleeves 'adapted to be fitted' over insulating jacket imparts structural limitation to sleeve rather than merely directing activities to take place in future; structures of components of completed assembly may be defined in terms of interrelationship of components, or attributes they must possess, in completed assembly.

"We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly. More particularly, we find nothing indefinite in these claims.

"Moreover, although the claims before us contain some language which can be labelled 'conditional,' this language,

rather than describing activities which may or may not occur, serves to precisely define present structural attributes of interrelated component parts of the 'kit', such that a later assembly of the 'kit' of parts may be effected."

The claim 40 has been amended in a manner analogous to that discussed above with reference to the parent claim 36. This claim 40 now explicitly points out that the intermediate member (such as 140 recited in the immediately preceding claim 39) includes means for limiting the extent of movability of the at least one runner (such as 113) in at least one direction axially of the at least one housing (such as 102) when the runner (such as 113) is connected with the driven device (such as 10).

The amendments to the lines 4 and 13 of the claim 70 are analogous to those discussed above in relation to the claims 36 and 40. The expression "connectable" in line 14 of the claim 70 need not be replaced by --connected-- or the like because those passages of the claim 70 which follow "connectable" in line 14 of the claim 70 as originally submitted do not require the recitation of a positive connection between the output element (such as 14) and a driven shaft (such as 10).

The indicated allowability of the claims 36 through 47 (please refer to the first two paragraphs on page 7 of Paper No. 11) is gratefully acknowledged.

The amended claim 70 now positively recites that

the first and second components (such as 34 and 19) are rotatable relative to each other against the resistance of the springs (such as 20, 21) forming part of the damper (such as 16) which operates in series with the bypass clutch or lockup clutch (such as 18). Furthermore, the amended claim 70 recites that the springs (such as 20, 21) are operative to transmit torque between the rotor (such as 13) and the driven shaft (such as 10) in the disengaged condition of the bypass clutch (such as 18). The novelty of such features and the reasons why the thus amended claim 70 even more accurately distinguishes over the applied art will be discussed below.

Applicants believe that the Primary Examiner's interpretation of the disclosure in the Japanese patent No. 54-145860 to Toyota (hereinafter Toyota) warrants some important reconsideration for the following reasons:

The statement in lines 3-4 of the last paragraph on page 4 of Paper No. 11, namely that the carrier or hub 26 in the apparatus of Toyota contains stressing means 27, 28 connected to the runner 10 by a weld for rotating therewith, appears to be incorrect. On the contrary, the two "disc-shaped members" 27, 28 in the apparatus of Toyota are rotatable relative to the runner 10 (i.e., they are not welded to the runner) and, therefore, the members 26, 27 do not form part of the carrier or hub 26.

Furthermore, whereas the lines 6-7 in the last column on page 4 of Paper No. 11 contain the accurate statement that the runner 10 is connected to a rotary driven device 13 via hub 12, the arguments and observations in the paragraph bridging the pages 8-9 of Paper No. 11 contain (in lines 7-8 of the last paragraph on page 8) the statement that the "driven device" is the engine 1, 2. Thus, the interpretation of the apparatus of Toyota in the Primary Examiner's Response to Amendment appears to be basically different from that in the Claims Rejection - 35 USC Section 102.

Still further, the lines 9 to 12 in the last paragraph on page 4 of Paper No. 11 contain the statement that the energy storing device (i.e., the springs 25) of Toyota acts between the runner 10 and the driven device 13 via hub 12. This observation appears to warrant reconsideration for reasons which will be apparent upon an inspection of Figure 1 of the drawing in the patent to Toyota. Thus, the driven device 13 is the input shaft of a transmission and is non-rotatably connected with the runner 10, namely by way of the hub 12. The non-rotatable connection is established in the following way: The hub 12 is non-rotatably coupled to the shaft 13 by the gear teeth 14, and the hub 12 is non-rotatably coupled to the runner 10 by rivets (one shown but not referenced in Figure

1 of the Japanese patent). Thus, the springs 25 cannot act in the power flow between the runner 10 and the driven device (shaft) 13.

The piston 15 in the apparatus of Toyota can neither ensure nor effect that the springs 25 are effective between the runner 10 and the shaft 13. The sole purpose of the piston 15 in the apparatus of Toyota is to act in the transmission of torque between the housing 6 (i.e., the "driving device 1,2) and the runner 10 when the bypass clutch is engaged, i.e., at a location basically different from that called for, for example, in applicants' claim 1.

In the apparatus of the present invention, the damper transmits torque to the runner 13 also when the bypass clutch 18 is disengaged; this is evidently directly contrary to the teaching of Toyota. Applicants have duly noted the Primary Examiner's observation (in lines 3 et seq. of the last paragraph on page 8 of Paper No. 11) that the apparatus shown in applicants' "Figure 2 clearly shows the same features as shown in the Toyota reference". It is sincerely believed here that such interpretation of the apparatus of Toyota warrants careful reconsideration. Thus, when the bypass clutch in the patented apparatus is engaged, torque is being transmitted from the housing 6, by way of the piston 15 and the discs 27, 28 (which are

non-rotatably coupled with the piston), to the springs 25, from the springs 25 to the runner 10, from the runner to the hub 12 and thereupon to the driven device 13. On the other hand, the apparatus which is recited in applicants' Figure 1 operates in such away that, when the bypass clutch 18 is engaged, the transmission of torque does not take place by way of the runner (such as 113) because the runner 113 is rotatably mounted on the intermediate member 140. The transmission of torque to the driven device takes place through the medium of the flange-like member 134 which is non-rotatably connected to the hub 114. Thus, when the bypass clutch 118 is engaged, the springs 119 do not transmit torque to the runner 113 because such torque is being transmitted to the driven device directly by parts 134, 114. Furthermore, when the bypass clutch 118 shown in Figure 2 of applicants' drawings is engaged, there is established a non-rotatable connection between the runner 113 and the housing 102; on the other hand, when the bypass clutch of Toyota is engaged, the runner 10 of the patented apparatus can rotate relative to the housing 6 by way of the springs 25. Thus, it would appear that not only the construction but also the mode of operation of the apparatus shown in Figure 2 of applicants' drawings are basically different from those of the Toyota apparatus.

There are other important differences between the construction and mode of operation of applicants' apparatus and those of the apparatus which is disclosed in the Japanese patent to Toyota. For example, when the bypass clutch of applicants' apparatus is disengaged, the springs of the damper are capable of transmitting torque which is in clear contrast to the teaching of Toyota because, in the patented apparatus, the springs 25 do not serve to transmit torque when the bypass clutch is disengaged. Otherwise stated, the springs of the damper in applicants' apparatus can transmit torque in the engaged or disengaged condition of the bypass clutch whereas the apparatus of the Japanese reference operates in such a way that the springs 25 can transmit torque only and alone when the bypass clutch of Toyota is engaged. This important difference is now pointed out in the amended claim 25, in the claims 26-28 which refer to the claim 25, as well as in the claim 70.

The above explanations are believed to warrant a reconsideration of the Primary Examiner's observations in lines 3-7 on page 5 of Paper No. 11 (namely of the observation that the part 21 in the apparatus of Toyota is an output element). The part 21 is a bearing element which serves to axially movably support the piston 15, which is in sealing engagement with the piston, and which



serves as an axial abutment for the hub 12 to thus prevent axial movements of the runner 10. In other words, the bearing element 21 in the apparatus of Toyota does not and cannot transmit any torque.

For the foregoing reasons, the claims 1 and 70 (as well as all claims referring to the claim 1) appear to be directed to an invention which is clearly patentable over the disclosure of Toyota under 35 U.S.C. 102 as well as under 35 U.S.C. 103. As fully explained above, not only the construction but also the mode of operation of applicants' apparatus are basically different from the construction and mode of operation of the apparatus disclosed in the Japanese patent to Toyota.

Applicants respectfully request careful reconsideration of the rejection of claims 1-8, 11-17, 22-25 and 69 as being anticipated by the disclosure in the commonly owned US patent No. 5,377,796 to Friedmann et al. (hereinafter Friedmann). The fourth paragraph on page 9 of Paper No. 11 refers to Figures 7, 8, and 10-12 of Friedmann. Please note that, in the patented apparatus, the turbine wheel (such as 313 or 413) is rigidly connected with the hub (such as 314 or 414) which, in turn, is connected with and transmits torque to a driven element (such as the input shaft of a transmission). In other words, Friedmann does not disclose or suggest the provision of springs between

the turbine wheel and the hub or between the turbine wheel and the driven device (such as the input shaft of a transmission) or between the hub and the driven device.

Furthermore, applicants believe that the interpretation of the disclosure of Friedmann in the fourth paragraph on page 9 of Paper No. 11 warrants reconsideration on the additional ground that this paragraph refers to the parts 4, 5 (shown in Figure 1 of Friedmann) as a driven device. However, the parts 4, 5 shown in Figure 1 of Friedmann receive torque from the prime mover (such as an engine) and, therefore, they could be characterized as constituting or as forming part of a driving device.

The amended claim 25 is believed to be patentable over the disclosure of Friedmann on the additional ground that it recites that the damper comprises at least one energy storing element which can transmit torque in the disengaged condition of the bypass clutch. This feature is evidently lacking in the apparatus of Friedmann. When the bypass clutch of Friedmann is disengaged, the transmission of torque takes place from the turbine wheel directly to the hub, i.e., to the driven device.

The claims 9 and 10 are believed to be patentable over Friedmann under 35 U.S.C. 103 because they refer to the aforesaid twice amended claim 1. Furthermore,

applicants believe that the Primary Examiner relies on an antiquated decision (In re Aller, 105 USPQ 233) which has been superseded by numerous decisions holding that, in the absence of art actually disclosing their features, claims of the type corresponding to applicants' claims 9 and 10 warrant patent protection. Attention is respectfully invited, for example, to the decision of the Board of Patent Appeals and interferences in In re Garrett (dated September 30, 1986 and reported on page 43 of Volume 33 of BNA's NEWS & COMMENT) wherein, in reversing an obviousness rejection, the Board criticized the Examiner's statement that the proposed modification would have been "an obvious matter of engineering design choice" with the observation that such an assertion is a conclusion, not a reason. Please note that, in this decision, the Board refused to consider as obvious an "engineering design choice" whereas the decision on which the Primary Examiner relies merely refers to "routine skill in the art".

This Paper is believed to place the case in condition for allowance with the claims 1-19, 21, 22, 24-27,, 29, 30, 36-47, 69 and 70, and such Action at an early date is earnestly solicited. If the Primary Examiner believes that a conference, either per telephone or at the United States Patent and Trademark Office, is advisable or necessary, applicants respectfully request that the Primary

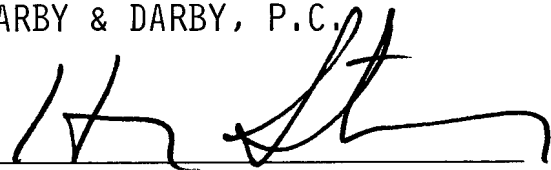
Examiner contact Peter K. Kontler (Reg. No. 20,384) by telephone at (941) 262 8492 in order to arrange for a conference at a time which will be acceptable and convenient to the Primary Examiner.

Date: April 11, 1996

Respectfully submitted,

DARBY & DARBY, P.C.

By

A handwritten signature in black ink, appearing to be 'H. Sternberg', written over a horizontal line.

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Encl.:

Petition with  
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